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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/436,281	11/08/1999	CHARLES ERIC HUNTER	WT-I-CIP	6394

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EXAMINER
KOENIG, ANDREW Y

ART UNIT PAPER NUMBER

2611
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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/436,281

Applicant(s)

HUNTER, CHARLES ERIC

Examiner

Andrew Y Koenig

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Continued Prosecution Application

1. The request filed on 3 April 2003 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/385,671 is acceptable and a CPA has been established. An action on the CPA follows.

The applicant has been notified and stated that no response or amendment would be filed.

All claims are drawn to the same invention claimed in the parent application prior to the filing of this Continued Prosecution Application under 37 CFR 1.53(d) and could have been finally rejected on the grounds and art of record in the next Office action. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing under 37 CFR 1.53(d). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,619,247 to Russo in view of U.S. Patent 4,789,863 to Bush.

4. Regarding claims 1 and 14, Russo teaches transmitting movies and music selections to customers via a cable television input or a satellite (col. 6, ll. 9-12), and permitting the user to pre-select and record a movie (Abstract); additionally, Russo, teaches that it is within in the scope to include audio selections (col. 6-7, ll. 65-3). Furthermore, Russo teaches playing back the preselected movie, (figure 1; col. 3-4, ll. 65-2). Russo teaches communicating the movie selection to a program provider (col. 6, ll. 9-12), which equates to a central controller system, the program provider of also bills the customers for the recorded selections and movies that actually played (col. 5, ll. 1-10). Russo is silent on billing customers for recording music.

Bush teaches billing the customer prior to recording a music selection (Abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Russo by bill customers for music recordings as taught by Bush in order to economically distribute music while simultaneously allowing the user to access and record the information thereby allowing more services accessible to the user.

Regarding claim 2, Russo teaches using a key to decode a program to permit viewing (col. 6, ll. 12-24, 46-53), which reads on encoding the movies to permit playback with compatible playback devices.

Regarding claim 3, Russo teaches using a CD-ROM to store audio and video programs (col. 7, ll. 44-51), but is silent on playing the CD in other devices. Bush teaches copying music to cassette tapes and CDs (col. 5, ll. 27-29), which clearly can be played back on conventional devices. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Russo by using a medium that can be played back on compatible devices such as tapes and CDs as taught by Bush in order to efficiently promote the music in the artist and reaping the benefits of a portable medium in that the user can listen to the music at their convenience.

Regarding claim 4, Russo teaches billing the customer based on their respective selections (col. 6, ll. 35-53).

5. Claims 5-6, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,619,247 to Russo and U.S. Patent 4,789,863 to Bush in view of U.S. Patent 4,809,325 to Hayashi et al.

Regarding claim 5, Russo teaches using satellites for a blanket transmission (col. 6, ll. 9-12), but fails to teach a direct broadcast satellite, optical fiber, cable modem, or the Internet. Hayashi teaches using a direct broadcast satellite (fig. 1, col. 2, ll. 54-62). Therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify Russo by using a direct broadcast satellite as taught by Hayashi in order to enhance services provided through satellites thereby enhancing the user's experience.

Regarding claim 6, Russo teaches sending transmissions of multiple channels (col. 6, ll. 55-62). Russo teaches using satellites for a blanket transmission (col. 6, ll. 9-12), but fails to teach a direct broadcast satellite, optical fiber, cable modem, or the Internet. Hayashi teaches using a direct broadcast satellite (fig. 1, col. 2, ll. 54-62). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Russo by using a direct broadcast satellite as taught by Hayashi in order to enhance services provided through satellites thereby enhancing the user's experience.

Regarding claim 24, the limitations of claim have been addressed in the discussion of claims 1, 3, and 5.

6. Claims 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,619,247 to Russo and U.S. Patent 4,789,863 to Bush in view of U.S. Patent 5,610,653 to Abecassis.

Regarding claim 7, Russo and Bush fail to teach transmitting movies time-compressed. Abecassis teaches burst downloads, which transmit compressed movies at a higher rate than which it would be in real-time (col. 37, ll. 50-54; col. 37-38, ll. 61-3). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify system of Russo and Bush by transmitting movies time-

compressed as taught by Abecassis in order to maximize the bandwidth within a channel, thereby minimizing the actual download times, thus maximizing efficiency.

Regarding claim 8, the limitations of claim 8 have been addressed in the discussion of claim 5.

Regarding claim 9, Russo and Bush fail to teach transmitting at a write speed faster than real-time, which is taught by Abecassis (col. 37, ll. 50-54; col. 37-38, ll. 61-3). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify system of Russo and Bush by transmitting movies time-compressed faster than real-time as taught by Abecassis in order to maximize the bandwidth within a channel, thereby minimizing the actual download times, thus maximizing efficiency.

Regarding claim 10, Russo, Bush and Abecassis are silent on teaching transmitting at rates 8-10 times real-time. Official Notice is taken that different rates are well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify system of Russo, Bush, and Abecassis by transmitting movies 8-10 times faster than real-time in order to maximize the bandwidth within a channel, thereby minimizing the actual download times, thus maximizing efficiency.

Regarding claim 11, Russo, Bush and Abecassis are silent on teaching resolution rates on the orders of VHS. Official Notice is taken that different resolutions are well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify system of Russo, Bush, and

Abecassis by transmitting movies at different resolution rates, such as VHS quality in order to reduce the size of the movie thereby maximizing the bandwidth within a channel, minimizing the actual download times, maximizing the storage capacity on the user's device, thus maximizing efficiency.

Regarding claim 12, Russo, Bush and Abecassis are silent on teaching 12 Mb/s or greater write speeds. Official Notice is taken that writing speeds are well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify system of Russo, Bush, and Abecassis by using a 12 Mb/s or greater write speed in order to reduce the time to actually store the movie at the user's device thereby minimizing the waiting time, thus creating a more user-friendly system.

7. Claims 13 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,619,247 to Russo and U.S. Patent 4,789,863 to Bush in view of U.S. Patent 5,438,355 to Palmer.

Regarding claims 13 and 15, the limitations of claims 13 and 15 have been addressed in the discussion of claim 1. Whereas Russo teaches databases for managing information at the user's device, Russo is silent on using a database at a central controller associated with an address. Palmer teaches a database (fig. 1, label 20) located at the central exchange, which maintains billing and address information (col. 3, ll. 33-40). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Russo by implementing a database as

taught by Palmer in order to maintain address and billing information thereby keeping accurate records and efficiently managing data.

8. Claims 15–19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,619,247 to Russo in view of U.S. Patent 4,789,863 to Bush and U.S. Patent 4,809,325 to Hayashi, and U.S. Patent 5,610,653 to Abecassis.

Regarding claim 15, the limitations of claim 15 have been addressed in the discussion of claims 1, 5, 9, and 13.

Regarding claim 16, the limitations of claim 16 have been addressed in the discussion of claim 12.

Regarding claim 17, the limitations of claim 16 have been addressed in the discussion of claim 12.

Regarding claim 18, the limitations of claim 16 have been addressed in the discussion of claims 10 and 11.

Regarding claim 19, Russo fails to teach transmitting movies time-compressed. Abecassis teaches burst downloads, which transmit compressed movies at a higher rate than which it would be in real-time (col. 37, ll. 50-54; col. 37-38, ll. 61-3).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify system of Russo and Bush by transmitting movies time-compressed as taught by Abecassis in order to maximize the bandwidth within a channel, thereby minimizing the actual download times, thus maximizing efficiency. Additionally, one of ordinary skill in the art would readily recognize the

transmission/recording times are dependent on bandwidth capacity of the network, writing and processing speeds, and the size of the data.

9. Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,619,247 to Russo, U.S. Patent 4,789,863 to Bush and U.S. Patent 4,809,325 to Hayashi, and U.S. Patent 5,610,653 to Abecassis in view of U.S. Patent 5,621,840 to Kawamura et al.

Regarding claim 20, Russo, Bush, Abecassis, and Hayashi are silent on teaching a memory buffer before recording. Kawamura teaches buffering data prior to recording (fig. 1; col. 1, ll. 28-41). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Russo, Bush, Abecassis, and Hayashi by buffering prior to recording as taught by Kawamura in order to prevent errors during writing, such as buffer under-running thereby implementing a more efficient and robust system.

Regarding claim 21, Russo teaches magnetic, optical, and magneto-optical mediums as storage, but is silent on using a buffer. Russo, Bush, Abecassis, and Hayashi are silent on teaching a memory buffer including a magnetic drive, optical drive, or magneto-optical drive. Kawamura teaches a memory buffer with the drive, where the drive is magneto-optical or magnetic (col. 1, ll. 28-41). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Russo, Bush, Abecassis, and Hayashi implementing the buffer including a drive such as a magnetic drive, or magneto-optical drive as taught by Kawamura in order to efficiently

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record data onto a medium without errors, thus creating a more robust and error tolerant system.

Regarding claim 22, Russo, Bush, Abecassis, Hayashi, and Kawamura are silent on teaching a memory buffer being DRAM, flash memory, SRAM, or a digital tape. Official Notice is taken that it is well known that different types of memory are well known in the art as buffers. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Russo, Bush, Abecassis, Hayashi, and Kawamura by using DRAM, flash memory, SRAM, or a digital tape as a buffer in order to effectively write data to a medium.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Y Koenig whose telephone number is (703) 306-0399. The examiner can normally be reached on M-Th (7:30 - 6:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

ayk
June 5, 2003


ANDREW FAILE
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